

## REMARKS

Claims 1, 3-13, 17-29, and 32-41 are currently pending. Claims 2, 14-16, and 31 have been canceled without prejudice or disclaimer. Claim 13 has been amended with the subject matter of canceled claims 14-16. Claims 9, 17, and 21 have been amended for clarification. Claims 1, 26, 27, 29, 32, and 38 have been amended with the subject matter of claims 2. Claim 3 has been amended for clarification. It is respectfully submitted that no new matter has been added.

### Double Patenting Rejection

The Patent Office rejected claims 1-29 and 31-41 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 6,765,891.

Laitinen, U.S. Patent No. 6,765,891, discloses that neighbor cell list type is indicated in a cell without a PBCCH allocated, by SI2quater message that indicates the same value of 3G\_BA\_IND and, in a cell with a PBCCH allocated, by PSI3quater messages indicating the same PSI3\_CHANGE\_MARK and, with an inventive aspect, the same 3G\_BA\_IND value. Paragraphs 0042, 0043, 0055, and 0056, of Laitinen disclose as follows:

[0042] In a cell without a PBCCH allocated, the MS 100 only combines 3G Neighbor cells from SI2quater messages that indicate the same value of the 3G\_BA\_IND, without any message indicating a different value of the 3G\_BA\_IND received in between.

[0043] In a cell with a PBCCH allocated, the MS 100 only combines 3G Neighbor cells from PSI3quater messages indicating the same PSI3\_CHANGE\_MARK value and, in accordance with this aspect of the invention, the same 3G\_BA\_IND value.

[0055] The 3G\_BA\_IND parameter has been specified above to be a 1-bit field. The values of the 3G\_BA\_IND in the PSI3quater message and in the SI2quater message are preferably equal so that the 3G Neighbor Cell list received on the BCCH/PBCCH can be unambiguously distinguished from the 3G Neighbor Cell list provided on the SACCH, i.e., in the MEASUREMENT INFORMATION message. Note that the network 10 does not know whether the MS 100 has decoded the initial 3G Neighbor Cell list from the BCCH or from the PBCCH.

[0056] Note, however, that since the MS 100 is not required to decode both BCCH and PBCCH, the 3G Neighbor Cell list received in the Idle/packet Idle mode can be readily distinguished from the 3G Neighbor

Cell list provided with the MEASUREMENT INFORMATION message. If, however, the 3G Neighbor Cell list given on the BCCH is required to be distinguished from the 3G Neighbor Cell list given on PBCCH, the 3G\_BA\_IND field can be expanded to be two or more bits, thereby enabling additional information to be specified. This change would require changes to following messages: SI2quater, PSI3quater, MEASUREMENT REPORT, ENHANCED MEASUREMENT REPORT, MEASUREMENT INFORMATION, PACKET MEASUREMENT REPORT, PACKET ENHANCED MEASUREMENT REPORT, PACKET CELL CHANGE ORDER and PACKET MEASUREMENT ORDER to accommodate the use of more than one bit for the 3G\_BA\_IND field.

The claims of U.S. Patent No. 6,765,891, recite “a 3G BA IND\_information element received in the PACKET SYSTEM INFORMATION Type 3quater message” and “the LSB of the PSI3\_CHANGE\_MARK information element being used by said controller as a 3G\_BA\_IND information element.” The claims of U.S. Patent No. 6,765,891, do not recite implicit specification of a neighbor cell list type or adding a bit field to a packet measurement report message if a packet broadcast control channel message only if the packet broadcast control channel is not present in the cell.

Applicant’s claim 13 recites, in pertinent part, as follows:

where the neighbor cell list is explicitly specified by the packet measurement report message by a field of the packet measurement report message, where the field is a one bit field for specifying that the packet measurement report is based on a broadcast control channel allocation general packet radio service or on a global system for mobile communications neighbour cell list received from a broadcast control channel, where the one bit field is added to the packet measurement report message only if the packet broadcast control channel is not present in the cell

U.S. Patent No. 6,765,891 does not anticipate or make obvious claim 13 because the claimed invention of claim 13 has a one bit field that is added only in the packet broadcast control channel is not present in the cell and U.S. Patent No. 6,765,891 does not teach or suggest the addition of the 3G\_BA\_IND and PSI3\_CHANGE\_MARK and suggests they are always present. The claims of U.S. Patent No. 6,765,891, do not recite that a one bit field that is added only in the packet broadcast control channel is not present in the cell.

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Claim 1 recites, in pertinent part, as follows: “where the neighbor cell list is implicitly specified by the packet measurement report message by casting the message in a format of an earlier version of the packet measurement report message that by default implies the type of list.”

U.S. Patent No. 6,765,891 does not teach or suggest implicit specification of a list type and does not recite such in the claims. In U.S. Patent No. 6,765,891, the 3G\_BA\_IND and PSI3\_CHANGE\_MARK fields always appear to be present.

Claims 9, 17, 21, 26, 27, 29, 32, and 38 recite subject matter to the above noted subject matter of claim 1.

Accordingly, claims 1, 3-13, 17-29, and 32-41 are patentably distinct over the claims 1-18 of U.S. Patent No. 6,765,891.

An early and favorable allowance of the currently pending claims is earnestly requested.

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